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In re Application of
ODELL, Joan, Tellefsen, et al.
U.S. Application No.: 09/462,972
PCT No.: PCT/US98/13992
International Filing Date: 07 July 1998
Priority Date: 11 July 1997
Attorney's Docket No.: BB1095
For: PLANT SUG1 HOMOLOGS

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: DECISION ON PETITION
: TO REVIVE ABANDONED
: APPLICATION UNDER 37
: CFR 1.137(b)
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This decision is issued in response to applicants' "Petition To Revive" filed on 14 January 2000. Applicants have been charged the required petition fee.

BACKGROUND

On 07 July 1998, applicants filed international application PCT/US98/13992 which claimed a priority date of 11 July 1997 and which designated the United States.

On 25 January 1999, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for submission of a copy of the international application (unless previously communicated by the International Bureau) and payment of the basic national fee was extended to expire thirty months from the priority date, i.e., 11 January 2000.

On 14 January 2000, applicants filed the Petition To Revive considered herein with accompanying materials.

DISCUSSION

37 CFR 1.137(b) permits the filing of a petition to revive an abandoned application where the abandonment resulted from an unintentional delay. A grantable petition under this section must include: (1) the required reply, unless previously filed; (2) the petition fee required by law;

(3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional;" and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

Regarding item (1), the "required reply," section 711.03(c) of the Manual of Patent Examining Procedures states that:

[g]enerally, the required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed.

Here, a copy of the international application was not required because the international application was filed with the United States Receiving Office. The "required reply" was therefore payment of the basic national fee. The Form PTO-1390 transmittal letter filed with the Petition To Revive on 14 January 2000 included the authorization to charge Deposit Account No. 04-1928 \$840 for the basic national fee. Thus, applicants have made a submission which would have been "sufficient to have avoided abandonment" had it been made in a timely manner, that is, on or before 11 January 2000. Accordingly, applicants have submitted the "required reply." Item (1) is satisfied.

Item (2) is the petition fee required under 37 CFR 1.17(m). The Petition to Revive provided authorization to charge Deposit Account No. 04-1928 for the petition fee. Item (2) is satisfied.

As for item (3), the only place in the Petition to Revive where the word "unintentional" is used is the following statement: "[t]he account these items were charged to was unintentional and thought to be a viable account." This ambiguous statement cannot be construed as being the statement required by 37 CFR 1.137(b)(3), that is, a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional." Item (3) under 37 CFR 1.137(b) is therefore **not** satisfied.

Under the terms of 37 CFR 1.137(c), the terminal disclaimer listed as item (4) above is not required for this application.

Applicants have therefore satisfied items (1), (2), and (4) of the requirements for a grantable petition under 37 CFR 1.137(b). However, they have failed to satisfy item (3). Accordingly, the Petition to Revive cannot be granted at this time..

In a separate submission, applicants have also requested a correction of the Notice Of Recordation Of Assignment Document issued by the USPTO. Specifically, applicants seek to have this Notice corrected to include 14 January 2000 as the filing date. As discussed above, this application currently is abandoned. Accordingly, correction of this Notice to include a 14 January 2000 filing date would be inappropriate at this time.

CONCLUSION

Applicants' Petition to Revive is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition to Revive" and should contain the statement required under 37 CFR 1.137(b)(3), as discussed above.

Extensions of time may be obtained under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to attention of the PCT Legal Office.



Leonard Smith
PCT Legal Examiner
PCT Legal Office

RMR/LS:rmr



Richard M. Ross
PCT Petitions Attorney
PCT Legal Office

Telephone: (703) 308-6155
Facsimile: (703) 308-6459